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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/441,142 11/12/99 MURRAY

94111-3834
EXAMINER

PM82/0413

MICHAEL E. WOOD
MCCUTCHEN, DOYLE, BROWN & ENERSON, LLP
THREE EMBAREADERO CENTER
SUITE 2500
SAN FRANCISCO CA 94111-4067

JAYNE, D
APT UNIT PAPER NUMBER

3627
DATE MAILED:

04/13/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on December 22, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 56-65, 71-82 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 56-65, 71-82 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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DETAILED ACTION

Election/Restriction

1. Upon review of this application, it has come to the attention of the examiner that applicants have failed to make an affirmation of the provisional election to prosecute the invention of figures 14-15 as set forth by the examiner in Paper No. 6 dated March 31, 2000. Such affirmation must be made by applicants in replying to this Office action.

Claim Rejections - 35 USC § 112

2. Claims 56-65 and 71-82 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 56, 61, 71, and 77, each contain claim language that "said locking arm moves relative to the housing when moving between said locked position and said unlocked position". The elected embodiment of Figures 14-15 includes slot engagement member 220 (i.e., locking arm) (specification, page 14, line 24) which is "integral with the bottom end 208 of housing 202" (specification, page 14, line 23). The examiner can find no support in the specification for the locking arm being moveable relative to the housing in any position. Appropriate correction or explanation is required.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 56, 59, 61, 64, 71, 74, 76, 77, 80, 82, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by German patent 3824393. A translation of this document can be found in application 08/138634 (Attmy. Ref. No. 14572P-002821US). With regard to claims 59, 64, 74 and 80 German patent teaches some measurable amount of rotation or swinging of the locking arm (5, Fig. 1). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

5. Claims 56-65 and 71-82, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sloop, Sr. 4,704,881. Sloop, Sr. teaches all the elements of the claimed invention including housing 66, moveable locking arm 62 with locking member 64, pin 76, and cable (shackle of padlock) for attachment to an object other than to the portable object (the body of the padlock 24 or the locking device itself). Sloop, Jr. teaches use of

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his barrel lock assembly with a conventional padlock. It is inherent in the prior art disclosure of Sloop, Jr that any conventional padlocks including those that have a flexible cable shackle are useable. In the alternative, the Examiner takes OFFICIAL NOTICE that padlocks having flexible cable shackles are well known. See Foote 3,765,197. It would have been obvious to one of ordinary skill in the art to use any conventional padlock including those that have a flexible cable shackle with the Sloop, Jr. barrel lock assembly. The curved contour of abutment 64 is considered to fit together/match/respond to a curved periphery of the apertures 44,42. The lock housing of Sloop, Sr. is a portable object which is prevented from being removed when in the locked position. Sloop, Sr. also teaches locking member 64 being maneuvered with slight angular or rotative movements until it engages the wall of the lock retaining means 38. See column 3, lines 38-43. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

7. Claims 56-65 and 71-82 are provisionally rejected under the judicially created doctrine of double patenting over any claims of any copending Applications which claim the same subject matters set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications listed on page 1 of applicant's disclosure and any other copending cases not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure. Because applicants are in a better position to know what applications are pending at the time of response to this office action and what is being claimed in those applications, applicants' shall provide such information for the which the Examiner will verify if the application is in condition for allowance. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a locking device with a locking member which locks down a piece of portable equipment having an aperture corresponding to the locking member with a cable.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP

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§ 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to several embodiments.

8. Claims 56-65 and 71-82 are rejected under the judicially created doctrine of double patenting over any claims of any U. S. Patents granted to applicants' which claim the same subject matter set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications which matured into patents listed on page 1 of applicant's disclosure and any other copending applications which have matured into patents not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. At a minimum, claims 56-65 and 71-82 are rejected under the judicially created doctrine of double patenting over **at least** claims 1-12 of U. S. Patent No. 5,502,989, claim 4 of U.S. Patent No. 5,381,685 and claims 1-7 of U.S. Patent No. 6,112,562. It is applicants duty to maintain a clear line of demarcation between different patentable embodiments of the various continuing applications and patents flowing from the 08/0006311 series and 08/385,715 series of patent applications in which William R. Murray, Jr., Stewart R. Carl and Arthur H. Zarnowitz are listed as co-inventors. Because applicants are in a better position to know what applications have matured into patents at the time of response to this office action and what is being claimed in those patents, applicants' shall provide such updated information for the which the Examiner will verify if this application is in condition for allowance.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to the several embodiments and the Examiner knows of at least U.S. Patent number 5,502,989 which claims the same invention elected in this application.

Response to Arguments

9. Applicants have indicated that appropriate terminal disclaimers will be filed upon issuance of the case, however, in order for response to this action to be responsive, applicants must provide a listing of pending applications and allowed patents so that the examiner may review such applications and patents for double patenting. If this application results in an appeal, applicants should indicate in any appeal that they do not intend a double patenting rejection to specific applications or patents to be a new ground of rejection since they are aware of their responsibility to provide the appropriate listing of pending applications and patents to the examiner.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Jayne whose telephone number is (703) 308-2492. The examiner can normally be reached on Monday-Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BethAnne Dayoan, can be reached at (703) 308-3865.

Submission of your response by facsimile transmission is encouraged. Group 3620's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

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I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____ (Date) _____

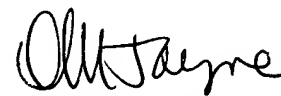
(Typed or printed name of person signing this certificate)

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist at (703) 308-2168.

April 8, 2001


DARNELL JAYNE
PRIMARY EXAMINER